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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,394	11/29/2000	Wesley W. Whitmyer JR.	03000- P0004C WWW/CJP	9725

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ST. ONGE STEWARD JOHNSTON & REENS, LLC  
986 BEDFORD STREET  
STAMFORD, CT 06905-5619

EXAMINER

NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/15/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,394

Applicant(s)

WHITMYER, WESLEY W.

Examiner

Cindy Nguyen

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

This is in response to amendment filed 06/24/03.

### **1. *Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S 5991752) in view of Watanabe et al. (U.S 6157947) (Watanabe).**

Regarding claims 1, 3 and 8, Rivette disclose: A system for automating the recordation of a property transfer comprising: an Internet server (310, 314, fig. 3 and corresponding text, Rivette);

a communications link between said Internet server and the Internet (306, 312, fig. 3 and corresponding text, Rivette);

at least one database containing a plurality of information records accessible by said Internet server (312, fig. 3 and corresponding text, Rivette), each information record including an intellectual property identification number and a jurisdiction identifier (604, 614, fig. 6 and corresponding text, Rivette);

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at least one database containing a plurality of recordation forms accessible by said Internet server, each information record including an intellectual property type identifier and a jurisdiction identifier (612, 626, 640, fig. 6 and corresponding text, Rivette);

However, Rivette didn't disclose: software executing on said Internet server for receiving a transfer request. On the other hand, Watanabe disclose: software executing on said Internet server for receiving a transfer request (col. 7, lines 19-35, Watanabe). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include software executing on said Internet server for receiving a transfer request in the system of Rivette as taught by Watanabe. The motivation being to enable the user to automatically retrieving the documents for recording the transfer of intellectual properties the network system.

In addition, Rivette/ Watanabe disclose: software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request (col. 7, lines 46-53, Watanabe); for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request (col. 7, lines 54 to col. 8, lines 3, Watanabe), and for combining the retrieved information record with the retrieved recordation form to generate a document (col. 8, lines 19-26, Watanabe). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the query for retrieving a recordation form corresponding to said transfer request and combining the retrieved information record with the retrieved recordation form to generate a document in the system of Rivette as taught by Watanabe. The motivation being to enable the user to automatically retrieving the documents for recording the transfer of intellectual properties the network system.

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Rivette/ Watanabe disclose: software executing on said Internet server for transmitting said property transfer request form through the Internet (col. 7, lines 54 to col. 8, lines 3, Watanabe);

software executing on said Internet server for receiving a reply to said property transfer request form (col. 26, lines 34-46, Rivette);

software executing on said Internet server for transmitting said transfer document through the Internet (col. 22, lines 56-65, Rivette).

software executing on said Internet server for querying said database of information records to retrieve information records corresponding to said intellectual property information request (col. 22, lines 66 to col. 23, lines 10, Rivette);

software executing on said Internet server for updating said database containing a plurality of information records (col. 32, lines 66-33, lines 9, Rivette).

Regarding claims 2, 4 and 9, most of the limitations of these claims have been noted in the rejection of claims 1, 3 and 8 above, respectively. In addition, Rivette/ Watanabe disclose: wherein said property is intellectual property such as patents, copyrights, and trademarks (col. 10, lines 17-28, Rivette).

Regarding claims 5 and 6, all the limitations of these claims have been noted in the rejection of claim 3. In addition, Rivette/ Watanabe disclose: comprising of software executing on said Internet server for receiving and transmitting an executed transfer document (col. 26, lines 34-46, Rivette).

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Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 3. In addition, Rivette/ Watanabe disclose: comprising of software executing on said internet server for transmitting said executed transfer document to a property recordation authority (col. 6, lines 42-64, Watanabe). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the software execution for transmitting said executed transfer document to a property recordation authority in the system of Rivette as taught by Watanabe. The motivation being to enable the user to secure transferring the intellectual properties over the Internet.

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 8. In addition, Rivette/ Watanabe disclose: comprising of software executing on said internet server for retrieving said updated to said database containing a plurality of information records through the internet from a plurality of sources (col. 38, lines 31-44, Rivette).

***Response to Arguments(06/24/03)***

Applicant's arguments have been considered, but are moot in view of the new ground(s) of rejection.

**3. Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roberts et al. (U.S 6292788). Methods and investment instruments for performing tax-deferred real estate exchanges.

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Stefik et al. (U.S 5634012). System for controlling the distribution and use of digital works having a fee reporting mechanism.

#### **4. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*CN*  
Cindy Nguyen  
July 2, 2003

*Frantz Coby*  
**FRANTZ COBY**  
**PRIMARY EXAMINER**